

aThe opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANSULRICH REISACHER and
JUAN ANTONIO GONZALEZ GOMEZ

Appeal 2007-1205
Application 10/501,343
Technology Center 1700

Decided: May 24, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and PETER F. KRATZ,
Administrative Patent Judges.

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1-12. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134. An Oral Hearing was held on May 08, 2007.

Appellants' invention is directed to a solid pigment preparation, a process of producing same, and processes for using such a preparation. The preparation includes at least one pigment, one or more nonionic surface-active agents, and one or more anionic surface-active agents, each in a specified amount. The nonionic additive is based on polyethers. The anionic surface-active additive is based on sulfonates, sulfates, polyphosphonates, or phosphates. Claim 1 is illustrative and is reproduced below:

1. A solid pigment preparation including as essential constituents
 - (A) from 60 to <90% by weight of at least one pigment,
 - (B) from 10 to <40% by weight of at least one nonionic surface-active additive based on polyethers, and
 - (C) from 0.1 to 10% by weight of at least one anionic surface-active additive based on sulfonates, sulfates, phosphonates or phosphates,
- the sum total of the weight percentages not exceeding 100% by weight.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Gonzalez-Blanco	US 6,110,266	Aug. 29, 2000
Nyssen	US 6,646,023	Nov. 11, 2003

In addition, the Examiner relies on the claims of the following copending application in an obviousness-type double patenting rejection:

Copending Application Serial No. 10/515,345

Claims 1-12 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting over claims 1-20 of

copending application No. 10/515,345. Claims 1-5, 7-10, and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gonzales-Blanco. Claims 6 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzales-Blanco in view of Nyssen.

We affirm the provisional obviousness-type double patenting rejection and reverse the anticipation and obviousness rejections. Our reasoning follows.

We start with the Examiner's rejection of claims 1-5, 7-10, and 12, as being anticipated by Gonzales-Blanco. The Examiner contends that Gonzales-Blanco discloses pigment preparations, which anticipate appealed claims 1-5, 7-10, and 12. Appellants contend that the preparation disclosed in Gonzales-Blanco does not meet the independent claim 1¹ requirements for a solid pigment preparation, the particular combinations of non-ionic and anionic surface-active additives required in appealed claim 1, and/or amounts thereof within the percentage ranges claimed.

Therefore, a dispositive question before us with respect to the Examiner's anticipation rejection is: whether the Examiner has established that Gonzales-Blanco describes a pigment preparation having all of the above-argued features; that is, the preparation is solid and includes non-ionic and anionic surface-active additives of the kind claimed and in the amounts claimed. We answer that questioning in the negative. Thus, we reverse the Examiner's anticipation rejection.

¹ Rejected claims 2-5 and 12 depend from claim 1. Method claims 7-10 require a process for forming the preparation of claim 1 or a process for pigmenting with the claim 1 preparation.

Here, the Examiner has not pointed out where in Gonzales-Blanco an anticipatory description of a solid pigment preparation that includes all of the above-identified claim features is provided. In this regard, the factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). While picking and choosing from among several options specific surfactants and amounts thereof based on the broad disclosure of Gonzales-Blanco would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103(a), such selection is not permissible in the context of an anticipation rejection. See *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

On this record, even if we found that Gonzales-Blanco discloses a solid pigment preparation intermediate as an option in forming the final pigment preparation (col. 8, ll. 26-32), such would not have saved the Examiner's anticipation rejection because of the above-noted picking and choosing of the surface-active additives and amounts thereof that is required in order to arrive at subject matter on which independent appealed claim 1 would read.

Accordingly, we reverse the anticipation rejection before us.

Turning to the Examiner's obviousness rejection of dependent claims 6 and 11, the Examiner relies on Gonzales-Blanco for the reasons set forth in the anticipation rejection. The Examiner does not otherwise explain why one of ordinary skill in the art would have found a teaching or suggestion of a pigment preparation corresponding to the independent claim 1 features in Gonzales-Blanco. Nor has the Examiner proffered any other logical reason

for such a modification so as to arrive at the features of rejected claims 6 and 11, which are incorporated therein by virtue of their dependency from claim 1. Given our determination above, respecting the lack of anticipation by Gonzales-Blanco, we are constrained to reverse the Examiner's rejection of dependent claims 6 and 11, on this record, in as much as this rejection is premised on that erroneous anticipation determination of the Examiner. See the "Other Issue" section below.

Concerning the provisional obviousness-type double patenting rejection, Appellants argue the rejected claims as a group. Thus, we select claim 1 as the representative claim on which we shall decide this appeal as to this grounds of rejection. Appellants contend that the claims of copending Application No. 10/515,345 do not suggest the less than 10 weight percent maximum for the anionic surface active additive component of representative claim 1. The Examiner, on the other hand, basically maintains that the weight percent range of anionic surface active additive required by representative claim 1 essentially abuts the greater than 10 weight percent lower end point of the range of weight percent for the anionic surface-active additive recited in claim 1 of the copending application. Given that adjacency of the here-claimed range and that in the copending application claim 1, the Examiner asserts that representative claim 1 is prima facie obvious over the claims of the copending application.

Therefore, the issue before us with respect to this rejection is: Whether Appellants have identified reversible error in the Examiner's provisional obviousness-type double patenting rejection? We answer that question in the negative and we shall affirm the Examiner's obviousness-type double patenting rejection, on this record.

In obviousness-type double patenting rejections, the analysis and issues involved correspond to those encountered in § 103(a) obviousness determinations, albeit the applied claims of the copending application or patent involved are not required to be prior art to the rejected claims. *See In re Longi*, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir.1985). In this regard, it is our view that the use of a slightly lower amount of anionic surface-active additive than expressly disclosed and embraced by claim 1 of the copending application would have been well within the ordinary skill of an artisan seeking to determine the result effectiveness and workability of employing differing amounts of this component in the pigment formulation. When the difference between the claimed invention and the prior art is a range or value of a particular variable, then a prima facie rejection is properly established when the difference in range or value is minor. *Hayes Int'l. Inc. v. Jessup Steel Co.*, 8 F.3d 1573, 1577 n.3, 28 USPQ2d 1652, 1655 n.3 (Fed. Cir. 1993).

After all, skill and not the converse is expected of an ordinarily skilled artisan. *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985). Moreover, we are bound to consider the disclosure of each reference for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. *See In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966); and *In re Preda*, 401 F.2d 825, 826-27, 159 USPQ 342, 344 (CCPA 1968). This reasoning also applies in establishing the obviousness of the representative appealed claim 1 over claim 1 of the copending application based on the adjacent ranges at issue in the obviousness-type double patenting rejection here.

Hence, we agree with the Examiner that Appellants' appealed claims represent obvious variations of the claims of copending Application No. 10/515,345, which prima facie case has not been persuasively rebutted by Appellants. Consequently, we affirm the Examiner's provisional obviousness-type double patenting rejection, on this record.

OTHER ISSUE

In the event of further prosecution of the subject matter of this application before the Examiner in this or a continuing application, the Examiner should consider whether or not one of ordinary skill in the art would have found a suggestion based on selections from the teachings of Gonzalez-Blanco, with or without other references, to make a solid pigment preparation corresponding to the claim 1 solid pigment preparation, as an intermediate or final product, in a manner so as to render the claim 1 subject matter prima facie obvious. If so, the Examiner should consider introducing an obviousness rejection of claim 1 over Gonzalez-Blanco alone or, in combination with any other references the Examiner may be aware of that would support such a rejection, during any such continued prosecution explaining in detail the reasons/rationale in support of any such rejection. Further, if such an obviousness rejection is introduced, the Examiner should determine whether or not such an obviousness rejection should be extended to any of the other pending claims. In this regard, we observe that whether or not the claim 1 subject matter would have been obvious within the meaning of § 103(a) over Gonzalez-Blanco was not developed by the Examiner on this record as an issue for resolution in this appeal.

CONCLUSION

The decision of the Examiner to reject claims 1-12 as standing provisionally rejected under the judicially created doctrine of obviousness- type double patenting over claims 1-20 of copending application No. 10/515,345 is affirmed. The Examiner's rejection of claims 1-5, 7-10, and 12 as standing rejected under 35 U.S.C. § 102(b) as being anticipated by Gonzales-Blanco and the rejection of claims 6 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Gonzales-Blanco in view of Nyssen is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

sld/ljs

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